

1714

RECEIVED
CENTRAL FAX CENTER

JUN 23 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of GATTO et al.

Application No.: 09/604,285

Filed: June 26, 2000

For: LUBRICANT CONTAINING MOLYBDENUM
COMPOUND AND SECONDARY DIARYLAMINE

OFFICIAL

T/C Group Art Unit: 1714
Examiner: Cepha Toomer

Confirmation No. 5162

Attorney Docket 7391/71214

June 23, 2004

SUBMISSION OF SUPPLEMENTAL REISSUE OATH

COMMISSIONER FOR PATENTS
U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop AF Reissue
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 2220224 pages total

Dear Sir:

Please enter this Supplemental Declaration for Continuation Reissue Application and pass this case on to allowance. It is intended to reflect claims as presented as of the June 14, 2004 Amendment.

This paper and the attached 23 page Supplemental Declaration are filed this date via facsimile to 703-872-9306 as confirmed by the signature hereinbelow.

Respectfully submitted,
FITCH, EVEN, TABIN & FLANNERYBy: Kendrew H. Colton
Registration No. 30,368
Tel: 202-419-7000
Fax: 202-419-7007Fitch, Even, Tabin & Flannery
1801 K Street, N.W., Suite 401L
Washington, D.C. 20006-1201

**RECEIVED
CENTRAL FAX CENTER**

JUN 23 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**OFFICIAL****In RE CONTINUATION PATENT APPLICATION:**

Appl. No. : 09/604,285 Confirmation No.: 5162
Applicant : GATTO et al.
Filed : June 26, 2000
TC/A.U. : 1714
Examiner : Cephia Toomer
For : LUBRICANT CONTAINING MOLYBDENUM
COMPOUND AND SECONDARY DIARYLAMINE

Docket No. : 7391/71214
Customer Nos.: 42798 (Washington, DC Office) 22242 (Chicago Office)

Hon. Commissioner of Patents
and Trademarks
220 20th Street S.
Customer Window – Mail Stop REISSUE
Crystal Plaza Two, Lobby, Room 1B3
Arlington, VA 22202

**SUPPLEMENTAL
DECLARATION
FOR CONTINUATION REISSUE APPLICATION**

Sir:

1. Vincent James Gatto and Mark Thomas Devlin each individually declare that our residence, post office address and citizenship are as respectively stated below next to our names and that we each verily believe we are the original joint and first inventors of the invention entitled Lubricant Containing Molybdenum and Secondary Diarylamine described and claimed in Letters Patent No. 5,650,381, issued on July 22, 1997 from our original application, serial number 08/559,879 filed on November 20, 1995, that I do know and do not believe that this invention was ever known or used in the United States before our invention thereof, or patented or

described in any publication in any country before our invention thereof, or more than one year prior to our original application, or in public use or on sale in the United States more than one year prior to our original application; that our invention had not been patented or made the subject of an inventor's certificate in any country foreign to the United States prior to the date of our original U.S. application number 08/559,879 on an application filed by me or my legal representatives or assigns more than twelve months before our said original application; and that I believe our original U.S. Patent No. 5,650,381 to be partly inoperative or invalid by the reasons of our claiming more or less than we had a right to claim, which error occurred without deceptive intention, and for which reason we filed this continuation application to continue patent prosecution of certain claims or their substantial counterparts from parent reissue application 09/359,770.

2. I hereby claim foreign priority benefits under 35 U.S.C. § 119/365 of any foreign application(s) for patent or inventor(s) certificate listed hereinbelow and have also identified below any foreign patent application for patent or inventor(s) certificate filed by me or my assignee disclosing the subject matter claimed in this application and having a filing date (1) before that of the application on which priority is claimed, or (2) if no priority is claimed, before the filing date of this application.

3. For the present continuation application for a reissue of U.S. Patent No. 5,650,381 ("original patent"), I hereby claim the domestic priority benefit under 35

U.S.C. 119/120/365 from our the United States reissue application No. 09/359,770 filed July 22, 1999, now U.S. Reissue Patent Re. 37,363E, and from United States Application No. 08/559,879 filed November 20, 1995, from which our original patent was granted.

4. I have reviewed and understand the contents of the above-identified specification in paragraph 1, and our continuation application for reissue filed on June 26, 2000, including both the new and amended claims which were submitted in the Amendment dated June 14, 2004. Upon present information and belief, this Supplemental Declaration For Continuation Reissue Application relates to the claims as presented herein as of the June 14, 2004 Amendment.

5. I acknowledge that the original patent has been assigned to Ethyl Corporation. I am informed that my assignment was recorded in the Assignment Branch of the U.S. Patent and Trademark Office on Reel 8380 at Frame 0823.

6. As stated herein in paragraph 1, I believe that our original U.S. Patent No. 5,656,381 contains an error(s) which occurred without deceptive intention. The error(s) was discovered after reviewing the claims of U.S. Patent No. 5,840,672, assigned to Ethyl Corporation.

7. After studying the claims of U.S. Patent No. 5,840,672, I recognized for the first time that the claims of U.S. Patent No. 5,650,381 contain an error in that we

claimed less we had a right to claim.

8. After reviewing the U.S. Patent No. 5,840,672, and upon further reviewing the issued claims in U.S. Patent No. 5,650,381, I recognized for the first time that the relative amounts of the molybdenum compound and secondary diarylamine may not have the scope to which we were entitled.

9. On information and belief original claims 1-21 in our U.S. Patent No. 5,650,381 and a further method claim 22 were allowed in our parent reissue application 09/359,770, which has now been granted as U.S. Patent Re. 37,363E. On information and belief, when the claims were originally presented in this continuation application for reissue, such claims or substantially the same claims were still concurrently being presented in our parent reissue application, filed July 22, 1999. Upon information and belief said such claims or substantially the same claims in our parent reissue application were subsequently canceled without prejudice but after our continuation application for reissue was filed. We filed the claims herein in our continuation application for reissue, application number 09/604,285, for the reasons stated herein above in paragraphs 1-8.

10. Independent claims 22 and 23 herein relate to lubricating compositions in which the amounts of one recited ingredient versus the other are based on the weight ratios disclosed in our specification at column 6, lines 46-50. The range of oil soluble secondary diaryl amine, as expressed in parts per million, in claim 22 is described throughout the specification. A lubricating composition in which the molybdenum compound provides 100 ppm or more of molybdenum as expressed in claim 22 is

described throughout the specification, including, for instance, the Examples. The range of molybdenum, as expressed in parts per million, that is provided by an oil soluble molybdenum compound as in claim 23 is described throughout the specification, including Example 5. Upon information and belief, I believe that claims 22-23 reflect an effort to ensure that the subject matter of our invention is recited so as to avoid the mistake recounted in paragraphs 1-8 supra.

11. As originally filed, claim 24 depended from claim 22 or 23, and recited the oil soluble molybdenum compound is substantially free of sulfur consistent with column 3, lines 36-40 and column 8, last two lines of the originally filed specification. This embodiment is not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have in U.S. Patent No. 5,650,381, and claim 24 was included in our continuation application for a reissue the aforesaid U.S. Patent. Upon information and belief claim 24 has been canceled without prejudice in our continuation application for a reissue of U.S. Patent No. 5,650,381.

12. Claims 25-29 in our reissue continuation application are dependent upon independent claims 22 or 23. Upon information and belief claims 25-29 are consistent with claims 22 and 23 in this continuation application for a reissue and the subject matters thereof are described throughout the original specification, including column 2, Summary of the Invention; and column 5, lines 49-63. We did not claim all that we could have in U.S. Patent No. 5,650,381. But if we submitted only claims 22 and 23, I realized that we would still not be claiming all that we could have, and claims 25-29 have been included in our reissue application.

13. Dependent claim 30 recites species of the molybdenum compound and the subject matter is disclosed in the present specification at column 10, Example 2 (molybdenum naphenate), column 13, Example 4 (molybdenum octoate), and column 14, Example 5 (molybdenum 2-ethylhexanoate). The molybdenum compounds in claim 30, in combination with claim 22 or 23, were not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have in U.S. Patent No. 5,650,381, and dependent claim 30 has been included in our continuation application for a reissue of the aforesaid U.S. Patent.

14. Dependent claims 31-40 recite more particularly the molybdenum compound. Upon information and belief claims 31-40 are consistent with claims 22 and 23 in this continuation application for a reissue and the subject matters thereof are described throughout the original specification, including column 3, lines 48-54; column 5, lines 49-63; column 5, lines 3-26; column 3, lines 60-61; column 4, last 6 lines to column 5, lines 1-2 of the present specification. Upon information and belief, we understand that the word "quantity" has been corrected in claim 31, and that the punctuation changes in claims 34 and 37 in the Amendment of June 14, 2004 involved inserting a "," and changing a "." to a ",". The embodiments as recited in dependent claims 31-40, in combination with claims 22 or 23, were not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have in U.S. Patent No. 5,650,381, and dependent claims 31-40 have been included in our continuation application for a reissue of the aforesaid U.S. patent.

15. As originally presented herein, claim 41 depended upon claims 22 or 23. Claim 41 related to column 4. Claim 41, in combination with claim 22 or 23, was not specifically claimed in U.S. Patent No. 5,650,381 but could have been. We did not claim all that we could have in U.S. Patent No. 5,650,381, and claim 41 was included in our continuation application to reissue the aforesaid U.S. patent. Upon information and belief, claim 41 has been canceled without prejudice or disclaimer.

16. Claims 42-44 further pertain to the oil soluble molybdenum compound in claims 22 or 23. Claim 42 relates to the Examples and column 4. Claim 43 relates to the specification at column 4, numbered paragraph 3. Claim 44 relates to the specification at column 4, at numbered paragraph 4. Dependent claims 42-44, in combination with claim 22 or 23, were not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claims 42-44 have been included in our continuation application for a reissue of the aforesaid U.S. patent.

17. Claim 45 depends from claim 22 or 23 and recites a secondary diarylamine as disclosed in the present specification, such as at column 6, lines 1-15. Claim 45, in combination with claim 22 or 23, was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 45 has have been included in our continuation application for a reissue of the aforesaid U.S. patent.

18. Claim 46 depends from claim 22 or 23 and recites that an oil soluble

secondary diarylamine according to a formula at column 6, lines 1-15. Claim 46, in combination with claim 22 or 23, was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 46 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

19. Claim 47 depends from claim 46 and relates to an oil soluble secondary diarylamine as described in column 6, sixth line after the formula. Claim 47, in combination with claim 46, was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 47 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

20. Claim 48 depends from claim 46, and relates to aryl groups in an oil soluble secondary diarylamine as described in column 6, lines 1-15. Claim 48, in combination with claim 46, was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 48 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

21. Claim 49 depends from claim 46 and relates to aryl groups in an oil soluble secondary diarylamine as described in column 6, lines 1-15. Claim 49, in combination with claim 46, was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No.

5,650,381, and dependent claim 49 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

22. Claim 50 depends from claim 46 and relates to the aryl groups in an oil soluble secondary diarylamine as described in column 6, which includes column 6, lines 1-15. Upon information and belief, we understand a punctuation change in claim 50 in the Amendment of June 14, 2004 involved changing a "." to a "," before the transition to the expression commencing with "wherein" and changing the expression "6 to 18 carbon atoms" to read "4 to 18 carbon atoms." The latter amended expression is described in the specification at column 6 at lines 9-12 following the formula and at lines 28-29 ("dibutyldiphenylamine") following the formula. Upon information and belief, we understand that Claim 50, in combination with claim 46, was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 50 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

23. Claim 51 depends from claim 22 or 23 and recites the lubricating composition can include an additive according to column 8, lines 21-23. Claim 51, in combination with claims 22 or 23, was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 51 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

24. Independent claim 52 is directed to a method of obtaining a lubricant

having improved antioxidancy and friction properties. Upon information and belief, claim 52 is consistent with the description throughout our original specification, including column 2, Summary of the Invention and columns 14-15. Claim 52 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and claim 52 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

25. Claim 53 was directed to a method for lubricating an automotive or truck crankcase or transmission with a composition according to claim 22 or 23. Claim 54 recited a lubricated crankcase or transmission obtained by method of claim 50. Upon information and belief, claims 53 and 54 related to one or more of the utilities recited at column 3, lines 9-11, column 6, line 27, column 7, lines 52-55, column 8, penultimate paragraph. Claims 53 and 54 were not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claims 53 and 54 were presented in our continuation application for a reissue of the aforesaid U.S. patent. Upon information and belief, claims 53 and 54 have been canceled without prejudice.

26. Upon information and belief, dependent claim 55 was a variant of claim 41 and the subject matter thereof is described in the specification as stated above as to claim 41. Claim 55 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and, upon information and belief, dependent claim 55 was presented in our continuation application for a reissue of the aforesaid U.S. patent. Upon information and belief, claim

55 has been canceled without prejudice.

27. Claim 56 recites a method of lubricating an engine comprising adding a lubricating composition of claim 22 or 23 to the engine and the subject matter of the claim is described in the specification, including the Examples, such as Example 7. Claim 56, in combination with claim 22 or 23, was not specifically claimed in the original U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and claim 56 was presented in our continuation application for a reissue of the aforesaid U.S. patent.

28. Claim 57 recites an engine lubricated according to a method of claim 56, and the subject matter thereof is described in the specification, including the Examples, and attention is drawn to Example 7. Claim 57 was not specifically claimed in the original U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and, upon information and belief, claim 57 was presented in our continuation application for a reissue of the aforesaid U.S. patent.

29. Claim 58 depends from claim 22 and states the oil soluble molybdenum compound is a molybdenum carboxylate or an organic amide molybdenum complex. Upon information and belief, the subject matter thereof is described in the original specification and attention is drawn, for instance, to column 2, the Summary of the Invention, the Examples, columns 14-15. Claim 58 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have

claimed in U.S. Patent No, 5,650,381, and dependent claim 58 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

30. Claim 59 depends from claim 22 and states the oil soluble molybdenum compound provides about 104 ppm molybdenum, which is described in the specification at column 15, lines 11-53. Claim 59 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No, 5,650,381, and dependent claim 59 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

31. Claim 60 depends from claim 22 and states that the oil soluble molybdenum compound provides 156 ppm molybdenum, which is described in the specification, including column 15, lines 11-53. Claim 60 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No, 5,650,381, and dependent claim 60 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

32. Claim 61 depends from claim 22 and recites an oil soluble molybdenum compound present provides 468 ppm of molybdenum, which is described in the specification at column 15, lines 11-53. Claim 61 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No, 5,650,381, and dependent claim 61 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

33. Claim 62 depends from claim 22 and recites various supplemental antioxidants. It finds basis in the specification at column 7, lines 43-46. Claim 62 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 62 has have been included in our continuation application for a reissue of the aforesaid U.S. patent.

34. Claim 63 depends from claim 23 and recites various supplemental antioxidants. It finds basis in the specification at column 7, lines 43-46. Claim 63 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 63 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

35. Claim 64 is directed to a lubricating composition and, upon information and belief, claim 64 finds basis in the original specification throughout. The oil soluble molybdenum compound is a molybdenum carboxylate as disclosed in columns 4 and 5. The secondary diarylamine compound comprises an alkylated diphenyl amine compound as described, for instance, at columns 5-6 and also, for instance, at column 14, penultimate line. The amount of molybdenum provided by the molybdenum compound finds support in the original specification, such as in the Summary of the Invention taken with Table V, and column 5, lines 60-63 ("based on the weight of said lubricating composition"). The specification discloses a basis for the range of about 104 ppm to 468 ppm molybdenum in the specification throughout, and attention is drawn, for instance, to

Example 5. The ratio of the molybdenum to the parts by weight of the secondary diarylamine is described in the original specification at, for instance, column 6, lines 47-56. Providing the oil soluble diarylamine is present in an amount equal to or greater than 750 ppm is consistent with the description throughout the specification, including, for instance, columns 2 and 6. Claim 64 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 64 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

36. Claim 65 depends from claim 64 and relates to an oil soluble molybdenum compound providing between 104 and 156 ppm molybdenum. Claim 65 finds support in the specification, including Table V and column 15, lines 50-52. Claim 65 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 65 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

37. Claim 66 depends from claim 64 and relates to an oil soluble molybdenum compound providing 468 ppm molybdenum. Claim 66 finds support in the original specification in column 15, Table V. Claim 66 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 66 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

38. Claim 67 depends from claim 64 and relates to a lubricating composition

that is free of a supplemental antioxidant that is selected from the group consisting of sulfurized phenols, sulfurized olefins, dialkyl dithiocarbamates and phenothiazines. Claim 67 finds support in the original specification throughout, including, for instance, column 7, lines 36-51. Claim 67 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 67 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

39. Claim 68 depends from claim 64 and relates to a molybdenum compound that is at least one of molybdenum naphthenate, molybdenum octoate or molybdenum 2-ethylhexanoate. Claim 68 finds support in the original specification throughout, including, for instance, column 4, last several lines to column 5, line 48 and the Examples. Claim 68 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 68 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

40. Claim 69 depends from claim 64 and relates a lubricating composition in which the amount of molybdenum is up to about 450 ppm. Claim 69 finds support in the original specification throughout, including, for instance, column 5, lines 54-56, among other passages. Claim 69 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 69 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

41. Claim 70 depends from claim 64 and relates to a lubricating composition in which the amount of molybdenum is from 125 ppm to 250 ppm. Claim 70 finds support in the original specification throughout, including, for instance, to column 5, lines 58-69, among other passages. Claim 70 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 70 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

42. Claim 71 depends from claim 64 and relates to a lubricating composition in wherein the oil soluble secondary diarylamine is present in an amount of about 750 to about 5,000 parts per million of the lubricating composition. Claim 71 finds support in the original specification throughout, including, for instance, to column 2, column 5 and column 6. Claim 71 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 71 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

43. Claim 72 depends from claim 64 and relates to a lubricating composition wherein the ratio of molybdenum provided by the oil soluble molybdenum compound relative to the oil soluble secondary diarylamine is about 0.04 to 0.4 parts by weight molybdenum per part of the secondary diarylamine. Claim 72 finds support in the original specification throughout, including, for instance, to column 6, lines 12-21 from the end. Claim 72 was not specifically claimed in U.S. Patent No. 5,650,381, but could

have been. We did not claim all that we could have claimed in U.S. Patent No, 5,650,381, and dependent claim 72 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

44. Claim 73 depends from claim 64 and relates a lubricating composition wherein the ratio of molybdenum provided by the oil soluble molybdenum compound relative to the oil soluble secondary diarylamine is about 0.05 to 0.3 parts by weight molybdenum per part of the secondary diarylamine. Claim 73 finds support in the original specification throughout and, for instance, to column 6, lines 12-21 from the end. Claim 73 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No, 5,650,381, and dependent claims 42-44 have been included in our continuation application for a reissue of the aforesaid U.S. patent.

45. Claim 74 relates to a method for lubricating an internal combustion engine comprising adding a lubricating composition according to claim 64 to the engine. Claim 74 finds support in the original specification throughout, including, for instance, columns 14-15, Example 7, and column 16. Example 7 discloses lubricating an internal combustion engine with a composition that is, upon information and belief, in accord with claim 64. Claim 74 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No, 5,650,381, and dependent claim 74 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

46. Claim 75 relates to an internal combustion engine lubricated according to the method of claim 74. Claim 75 finds support in the original specification throughout, including, for instance, columns 14-15, Example 7 and columns 16. Example 7 discloses an internal combustion engine lubricated with a composition that, upon present information and belief, is in accord with claim 64. Claim 75 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 75 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

47. Claim 76 relates to a lubricating composition that recites an antioxidant combination, and finds support in the specification throughout, including the reference to the antioxidant mixture of components disclosed at column 8, lines 51-52 ("[t]he molybdenum/diaryl amine based antioxidant mixture ..."). The amount of secondary diaryl amine is described throughout our original specification. The amount of molybdenum from the oil soluble molybdenum compound is described according to a ratio and the ratio is disclosed at column 6, lines 47-56. The recitation of at least about 100 ppm of molybdenum is described in our original specification inasmuch as the original specification discloses from about 100 ppm and greater amounts as described, for instance, in column 15, including Table V, which discloses 104 ppm molybdenum, provided the overall range for molybdenum is described within the claim via the ratio. Claim 76 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 76 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

48. Claim 77 depends from claim 76 and relates to a secondary diarylamine as consisting essentially of a secondary diphenyl amine and this finds support in the original specification throughout, including, for instance, column 6. Claim 77 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 77 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

49. Claim 78 depends from claim 76 and relates to an oil soluble molybdenum carboxylate compound in which the carboxylate anion has from 4 to 30 carbon atoms. Claim 78 is consistent with the original specification throughout, including, for instance, columns 4 and 5. Claim 78 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claim 78 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

50. Claim 79 depends from claim 76 and claim 80 depends from claim 79, and, they respectively relate to a lubricating composition in which the oil soluble secondary diarylamine is present in an amount of about 1,000 to 4,000 and in an amount of 1,200 to 3,000 parts per million. Upon information and belief, the subject matter of both claims is described in the original specification throughout, including, for instance, column 6, lines 31-22 from the bottom. Claims 79 and 80 were not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and dependent claims 79 and 80 have been

included in our continuation application for a reissue of the aforesaid U.S. patent.

51. Claim 81 is an independent claim and recites a major amount of lubricating oil, at least one oil soluble molybdenum compound that is free of phosphorus and free of active sulfur, and at least one oil soluble secondary diarylamine, wherein the ratio of molybdenum provided by said oil soluble molybdenum compound relative to said oil soluble secondary diarylamine is about 0.02 to 0.6 parts by weight molybdenum per part of said secondary diarylamine, wherein said oil soluble molybdenum compound is present in an amount to provide greater than about 100 parts per million of molybdenum based on the weight of said lubricating composition, provided said oil soluble secondary diarylamine is present in an amount up to 5,000 ppm based on the weight of said lubricating composition. Claim 81 finds support in the original specification throughout, including passages cited hereinabove as to claims 22 and 23, such as column 6, lines 54. Claim 81 was not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,650,381, and, upon information and belief, claim 81 has been included in our continuation application for a reissue of the aforesaid U.S. patent.

52. As stated herein, we claimed less than we had a right to claim in U.S. Patent No. 5,650,381 and for this reason presented the further claims 22-40, 42-52 and 56-81. The failure to claim all that we could have claimed was first appreciated by me upon reviewing the claims in U.S. Patent No. 5,650,381 in view of the hereinabove mentioned U.S. Patent No. 5,840,672. The failure to claim all that we could have claimed was an error and constitutes an insufficiency in the claims in U.S. Patent No.

5,650,381. This error(s) was without deceptive intention.

53. On information and belief, U.S. Patent No. 5,650,381 is not involved in any litigation or declared interference. On information and belief certain claims in our U.S. Patent No. 5,650,381 were the subject of a request for reexamination, which was granted and later merged with our parent reissue application 09/359,770. Upon information and belief all original claims 1-21 and a method claim 22 in said merged reissue were held allowable and U.S. Re. 37,363E was granted for such claims.

54. WHEREFOR I PRAY that we each may be allowed to rely upon the surrender of our said U.S. Letters Patent No. 5,650,381 in the parent application 09/359,770 to reissue said U.S. Letters Patent, and pray that such surrender, now made therein, suffices for this continuation application wherefore a Reissue Letters Patent may be issued for the inventions described by the foregoing claims in the present continuation application.

55. I acknowledge the duty to disclose all information known to me to be material to patentability as defined in 37 C.F.R. 1.56 to the claims submitted in my reissue application.

06/23/04 WED 13:57 FAX 804 7885519

ETHYL LAW DEPT.

002

56. I HEREBY DECLARE that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this reissue application or any patent issued thereon.

Full name of sole or one joint inventor:

Vincent James
James Vincent Gatto

(Given names first, with Family name last)

Inventor's signature:

Vincent James Gatto

Date:

June 23, 2004

Residence:

Baton Rouge, Louisiana

Post Office Address:

(City, State for U.S. Residents; City and Country for others)
17639 Five Oaks Drive

Baton Rouge, Louisiana 70810

Citizenship:

United States of America

Full name of one joint inventor:

Mark Thomas Devlin

(Given names first, with Family name last)

Inventor's signature:

Date:

Residence:

(City, State for U.S. Residents; City and Country for others)
13312 Herringbone Place

Post Office Address:

Richmond, Virginia 23233

Citizenship:

United States of America

56. I HEREBY DECLARE that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this reissue application or any patent issued thereon.

Full name of sole or one
joint inventor:

James Vincent Gatto
(Given names first, with Family name last)

Inventor's signature:

Date:

Residence:

Baton Rouge, Louisiana
(City, State for U.S. Residents; City and Country for others)

Post Office Address:

17639 Five Oaks Drive

Baton Rouge, Louisiana 70810

Citizenship:

United States of America

Full name of one
joint inventor:

Mark Thomas Devlin
(Given names first, with Family name last)

Inventor's signature:

Date:

Residence:

Mark Thomas Devlin

6/15/04

Richmond, Virginia
(City, State for U.S. Residents; City and Country for others)

Post Office Address:

13312 Herringbone Place

Richmond, Virginia 23233

Citizenship:

United States of America